

09/863,921

REMARKS

Claims 1 and 3-47, all the claims pending in the application, stand rejected on prior art grounds. Claims 6, 26, and 32 are amended herein. Applicants respectfully traverse these rejections based on the following discussion.

I. The Prior Art Rejections

Claims 1, 3-6, 15-32, and 42-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lerat (U.S. Publication No. 2002/0010627), in view of DeLapa, et al. (U.S. Patent No. 6,076,068), hereinafter referred to as DeLapa. Claims 7-14, and 33-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lerat, in view of DeLapa and Walker, et al. (U.S. Patent No. 6,327,573), hereinafter referred to as Walker. Applicants respectfully traverse these rejections based on the following discussion.

Lerat teaches a means to generate, distribute, exchange, verify and redeem coupons in a public network environment, such as the internet. This provides a safe way to create and distribute coupons from a manufacturer to one or more retailers, while at the same time giving the user all information corresponding to the coupon features.

DeLapa teaches a computer-implemented method and apparatus for generating coupons to provide discounts for purchases and includes providing a computer-based kiosk at a retail establishment such as a grocery store. A user identification of a household is received at the kiosk. The kiosk outputs a series of targeted coupons which have been assigned to the individual household on the basis of at least one attribute of that household. Images of coupons may be

09/863,921

formatted "on the fly" from parameters set forth in a coupon record. The system may further include an enhancement system which provides tools for enhancing the coupon offer data by designating particular offers as either a targeted coupon offer assigned to individual households as a function of purchases by that household or a mandatory coupon which is assigned to substantially all households. The kiosk may additionally print personalized messages by substituting for a keyword a value derived from an attribute of the identified household and outputting the graphic image of the personalized message.

Walker teaches a method enabling a frequent shopper reward system capable of tracking performance data of a plurality of members or account holders linked to a single frequent shopper account.

However, the claimed invention contains features which are patentably distinguishable from the prior art references of record. Specifically, independent claims 1, 22-23, and 25-27 recite, in part, "wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined." Similarly, independent claim 24 recites, in part, "wherein said promotional offer comprises a declinable value once said unspecified or variable parameters are defined." These features are not taught, suggested, or rendered obvious by Lerat, DeLapa, or Walker contrary to the assertions in the Office Action.

In fact, page 2 of the Office Action states, "Lerat teaches electronic coupons that are selected for downloading by users and that may include a parameter of value that is set to decline over time [abstract, ¶24]." However, the abstract of Lerat is bereft of any language pertaining to a declinable value or its equivalent. Furthermore, while paragraphs [0024] and [0069] generally

09/863,921

refer to a declined value of the coupon, there is nothing in these paragraphs or anywhere else in Lerat that teaches that the record of the promotional offer (or the promotional offer itself) comprises a declinable value once the unspecified or variable parameters are defined, and as the claimed invention clearly indicates, the unspecified or variable parameters are defined when the promotional offer is accepted or redeemed by respective customers. In Lerat, there is no indication that the coupons provide the declined value at the time of customer redemption or acceptance. Accordingly, Lerat does not teach all of the elements of the claimed invention. Likewise, neither DeLapa or Walker teach these features either.

In Applicants' invention, a customer can present his coupon to a store for redemption or determination of coupon parameters. When this occurs, the store determines the coupon parameters depending on the updated profile of the customer. This is distinct from Lerat and other random value coupons or time-decay coupons such as suggested in paragraph [0069] of Lerat (i.e., "time to live" coupon) as the value of the Applicant's offer is based on the updated profile of the customer and not merely on time or a random function. Accordingly, Lerat teaches away from the Applicants' claimed invention and irrespective of whether DeLapa and/or Walker are combined with Lerat, they still fail to teach, suggest, or render obvious all of the elements of the Applicants' claimed invention.

Insofar as references may be combined to teach a particular invention, and the proposed combination of Lerat and DeLapa and Walker with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a)

09/863,921

rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated:

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicant's novel claimed invention. Furthermore, the claimed invention meets the above-cited tests for obviousness by including embodiments such as "...said unspecified or variable parameters are defined when the promotional offer is accepted by respective customers, and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined." As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

09/863,921

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Lerat fail to disclose all of the elements of the claims of the present invention, particularly, the unspecified or variable parameters being defined when the promotional offer is accepted by respective customers, and wherein said record of the promotional offer comprises a declinable value once said unspecified or variable parameters are defined, as discussed above, but also, if combined with DeLapa and Walker, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Lerat, alone or in combination DeLapa and/or Walker teaches a structure and method containing all of the limitations of the claimed invention.

09/863,921

Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicant respectfully submits that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1 and 22-27 and as such, claims 1 and 22-27 are patentable over Lerat alone or in combination with DeLapa and/or Walker. Further, dependent claims 3-21 and 28-48 are similarly patentable over Lerat alone or in combination with DeLapa and/or Walker, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

II. Formal Matters and Conclusion

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

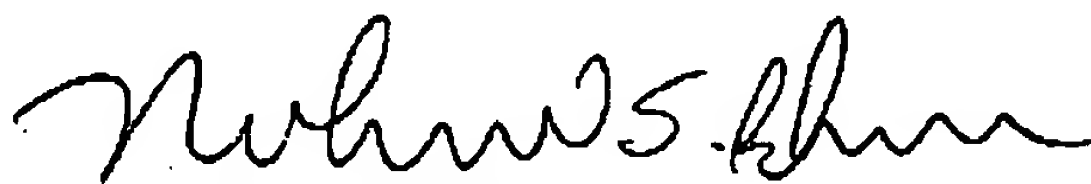
In view of the foregoing, Applicants submit that claims 1 and 3-48, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to

09/863,921

issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,



Dated: September 12, 2005

Mohammad S. Rahman, Esq.
Registration No. 43,029
Gibb IP Law Firm, LLC
2568-A Riva Road, Suite 304
Annapolis, MD 21401
Voice: (301) 261-8625
Fax: (301) 261-8825
Customer Number: 29154